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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,333	08/04/2003	Guenter Berschel	FA1194USNA	6771

23906 7590 05/19/2006

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EXAMINER

TSOY, ELENA

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/634,333

Applicant(s)

BERSCHEL ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-6,9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,9 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/25/2006 has been entered.

***Response to Amendment***

2. Amendment filed on 4/25/2006 has been entered. Claims 1, 3-6, 9, 11 are pending in the application.

***Claim Objections***

3. Claims 1, 3, 4, and 6 are objected to because of the following informalities: "solvent-based" should be changed to "organic solvent-based" for clearer understanding because solvent includes water and organic solvent.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-5, 9, 11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dattilo (US 6,291,018) and incorporated by reference Backhouse (US 4,220,679).

The Examiner Note: the recitation of *refinishing* has not been given patentable weight because the recitation occurs in the preamble, which merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Dattilo discloses a method of forming a multi-layer color-plus-clearcoating system for automotive applications (See column 1, lines 16-21) comprising applying a first liquid basecoat (See column 3, lines 61-66) containing color (non-effect) pigments or coloring agents (See column 5, lines 36-38) to a substrate precoated with a primer (See column 3, lines 29-36), applying a liquid second basecoat (See column 3, line 67) containing effect pigments (See column 5, lines 59-67), and applying thereon a liquid clearcoat\* layer (See column 9, lines 48-52; column 10, lines 2-54). Both the first and second basecoat materials are liquid, *preferably* waterborne, coating materials (See column 4, lines 12-15). Examples of *waterborne* basecoat materials suitable for use as first and/or second basecoat materials include those disclosed in incorporated by reference U.S. Pat. Nos. 4,147,679; 4,403,003; 5,401,790 and 5,071,904. Suitable film formers for *organic solvent-based basecoats* are disclosed in incorporated by reference U.S. Pat. No. 4,220,679 to Backhouse (See column 6, lines 8-20). In other words, *organic solvent-based basecoats* are not excluded in Dattilo. Therefore, any combination of *organic solvent-based basecoats* and *waterborne basecoats* can be used for forming first and second basecoats including claimed combination of a first *organic solvent-based basecoat* of Backhouse which is a two-component solvent-based basecoat containing diisocyanate crosslinking agent (claimed polyisocyanate) (See Backhouse, column 2, lines 5-6, 24-26, 36-37, 52-54) and a second *waterborne basecoat*.

\* clearcoat of Dattilo is claimed *lacquer* coat because “lacquer” by definition is “any of various clear or colored synthetic organic coatings that typically dry to form a film by evaporation of a solvent, as was discussed in Final Office Action mailed 12/20/2005.

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7. Claims 1, 3, 9, 11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Anderson et al (US 6,592,999).

As was discussed in paragraph 8 of the Office Action mailed on 7/26/2005, Anderson et al '999 disclose a method of forming a multi-layer color-plus-clearcoating system for automotive applications, with improved interlayer adhesion for easy repair of defects in clear coats or basecoats (See column 37, lines 19-40; column 55, lines 20-29). The method comprises applying to a substrate precoated with an electrocoat primer, a primer/surfacer and a basecoat by spray application with gray solventborne primer (claimed solid color paint)\* and a waterborne silver basecoat (claimed metallic effect pigment paint), applying powder clear coating compositions to the basecoat (See column 62, lines 22-48). The interlayer adhesion is improved by inclusion of adhesion promoters into conventional coating composition (See column 5, lines 1-10). Anderson et al further teach that the basecoat and transparent *topcoat* (i.e., **clearcoat**) compositions used in the multi-component composite coating compositions in certain instances can be formulated into **liquid** high solids coating compositions, that is, compositions containing 40 percent, or greater than 50 percent by weight resin solids (See column 35, lines 13-18) or can be formulated as powder coating compositions (See column 35, lines 22-24). The resinous binders for the **basecoat** can be **organic solvent-based** materials or **water-based** coating compositions (See column 35, lines 34-42). The topcoat (clearcoat)\*\* that can include any of the crosslinkable coating compositions such as waterborne clearcoats, solvent borne clearcoats and powder clearcoats (See column 36, lines 44-58). Therefore, in examples 31-33 (See column 62, lines 29-33, 47), a *waterborne* clearcoat or a *solvent borne* clearcoat can be used instead of powder clear coat, as required by Amendment.

Clearly, all three-layer coatings can be used for refinishing because of the improved interlayer adhesion between any of the layers, or it would have been obvious to one of ordinary skill in the art to have refinished the car painting using all three layer coatings depending on defects.

\* the gray solventborne primer of Anderson et al is claimed first *basecoat* of paint because terms "primer" and "basecoat" are used in the art interchangeably, as evidenced by references cited as a pertinent art; and because Applicants' specification fails to provide a definition of a term "basecoat". Moreover, in the "Summary of the

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**invention**", Applicants refer to first two layers as a first and a second color and/or effect-imparting *paint coats*, NOT as to *basecoats* thereby recognizing the fact that the term "basecoat" does not have any patentable meaning.

\*\* clearcoat of Anderson et al is claimed *lacquer* coat because "lacquer" by definition is "any of various clear or colored synthetic organic coatings that typically dry to form a film by evaporation of a solvent, as was discussed in Final Office Action mailed 12/20/2005.

8. Claims 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al in view of Kubitza et al (US 5075370) and Briselli et al (US 5,466,286) for the reasons of record set forth in paragraph 9 of the Office Action mailed on 7/26/2005.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al in view of Kubitza et al and Briselli et al, further in view of Schlaak (US 5,976,343) for the reasons of record set forth in paragraph 10 of the Office Action mailed on 7/26/2005.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references show that primer and a basecoat are used in the art interchangeably:

US 4,619,746 to Delaney et al (See column 2, lines 16-17);

US 4,720,403 to Jasenof et al (See column 2, lines 3-27);

US 5,612,093 to Braig et al (See column 15, lines 45-48).

### ***Response to Arguments***

11. Applicants' arguments filed 4/25/2006 have been fully considered but they are not persuasive.

Applicants argue that Applicants process requires the application of two base coats whereas Anderson applies a primer, a base coat and a powder basecoat.

The argument is unconvincing for the reasons discussed above.

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***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy  
Primary Examiner  
Art Unit 1762

**ELENA TSOY  
PRIMARY EXAMINER**



May 17, 2006